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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,842	02/27/2002	Jonas Grina	1392/2/2	2780

22847 7590 06/06/2005

SYNGENTA BIOTECHNOLOGY, INC.
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EXAMINER

RAO, DEEPAK R

ART UNIT PAPER NUMBER

1624

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/083,842

Applicant(s)

GRINA, JONAS

Examiner

Deepak Rao

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1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 09 December 2004. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

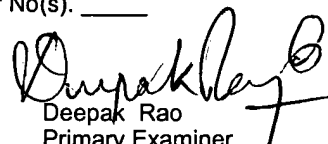
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Deepak Rao
Primary Examiner
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ADVISORY ACTION

The proposed amendments filed on May 31, 2005 continue to be indefinite as they will be subject to rejection under 35 U.S.C. 112, second paragraph and therefore, will not be entered.

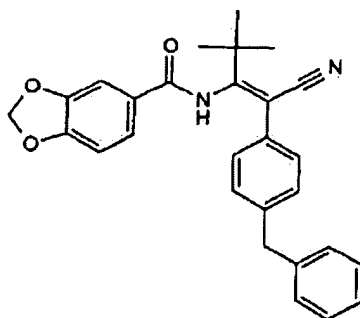
1. The recitation in claim 3 that "the substituents on R2 and R3 are joined to form cyclic structures on adjacent atoms of said aromatic ring" lacks antecedent basis in claim 1 on which claim 3 is dependent. Claim 1 does not provide any substituents for the aromatic rings defined under R2 and R3 wherein the substituents **together form a cyclic structure** (see portion of claim 1 depicted below):

R2 and R3

are each independently of the other unsubstituted or substituted aromatic rings, chosen from phenyl, pyridyl, pyrimidinyl, furyl, thiophenyl, pyrazinyl, pyrrolyl, pyrazolyl, 1,2,4-triazolyl, naphthyl, fluorenonyl, xanthenyl, 4-oxo-1,4-dihydro-(1,8)naphthyridinyl, thiazolyl, isothiazolyl, 1,3,4-thiadiazolyl, benzo-1,2,3-thiadiazolyl, oxazolyl, imidazolyl, quinolinyl, or isoquinolinyl, where a substituent on the rings is one or more chosen independently from hydrogen, C1 to C4 alkyl, alkoxy, alkoxyalkyl, hydroxy, amino, alkylamino, dialkylamino, acylamino, halo, haloalkyl, hydroxyalkyl, dihydroxyalkyl, alkoxycarbonyl, alkylaminocarbonyl, dialkylaminocarbonyl, unsubstituted or substituted alkylphenyl, unsubstituted or substituted phenyl, unsubstituted or substituted phenoxy, nitro, cyano, alkylthio, alkylsulfonyl, aminoalkyl, carboxyalkyl, or sulfonylalkyl;

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Applicant indicates that ‘the language used in the present amendment is essentially that used in the specification at page 13’. The specification at page 13 provides that “The substituents on R2 and R3 **may also be** joined to form cyclic structures on adjacent carbon atoms of the aromatic ring” (*emphasis added*) (see lines 10-11). As can be seen from this language, this limitation is in addition to the substituents already provided for R2 and R3 in the paragraph bridging pages 12-13. Accordingly, if applicant wishes to have this limitation in a dependent claim, it should first be recited in the base claim to provide proper antecedent basis, which is lacking in the instant independent claim 1. The substituent list provided for R2 and R3 in claim 1 do not provide any substituents that may be present on adjacent atoms and together form a cyclic structure. The limitation in claim 4 – ‘cyclic structure formed is selected from 1,2-methylenedioxy and 1,2-difluoromethylenedioxy’ also does not find antecedent basis for the above mentioned reason. Claim 14 is included in the rejection under 35 U.S.C. 112, second paragraph in the previous office action because it recites a species (depicted below for convenience):



wherein R3 is phenyl substituted with 1,2-methylenedioxy, for which there is insufficient antecedent basis in claim 1.

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2. There is insufficient antecedent basis in claim 1 or claim 8 for the recitation proposed for claim 9 – “said tautomeric compound is lactone”. Claim 9 depends from claim 8, however, claim 8 does not provide under formula II that ‘R3 and R4 together with the O form a cyclic structure’. The specification on page 13, under the definition of R4 provides that – “or cyclized together with R3 and O in Formula II to form a lactone” (see lines 7-8). A recitation having the above language is not present, which is required in the base claim(s) to provide sufficient antecedent basis for the subsequent claims 9 and 10.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

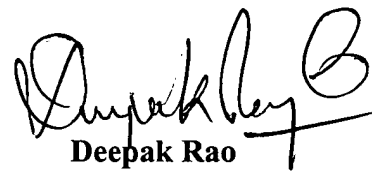
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Deepak Rao
Primary Examiner
Art Unit 1624

June 2, 2005